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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q65728

Daisuke NOHARA, et al.

Appln. No.: 09/923,533

Group Art Unit: 1714

Confirmation No.: 2113

Examiner: Katarzyna I. Wyrozebski Lee

Filed: August 8, 2001

For: ADDITIVE FOR RUBBER COMPOSITION, ADDITIVE COMPOSITION FOR RUBBER COMPOSITION, RUBBER COMPOSITION AND TIRE

RESPONSE UNDER 37 C.F.R. § 1.111

MAIL STOP NON-FEE AMENDMENT

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

This is responsive to the Office Action dated June 18, 2003.

REMARKS

Claims 1-21 are pending in the present application.

Claims 1-4, 9-11 and 14-16 have been rejected under 35 U.S.C. § 102(b) as being anticipated by JP 04-020579 to Igarashi. Additionally, Claims 5-8, 10-13 and 17-21 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,008,304 to Nohara.

Applicants respectfully traverse these rejections for the following reasons.

The present invention is to improving processability without degrading the properties of the rubber composition, which is attained by increasing slippage between rubber molecules with the presently claimed ester.

The ester of the present invention is (A) an ester of an aliphatic polyvalent carboxylic acid and a (poly)oxyalkylene derivative, or (B) an ester of an aromatic polyvalent carboxylic acid and a (poly)oxyalkylene derivative.

Igarashi (JP 04-020579) discloses (1) an ester of an unsaturated aliphatic acid having a carbon number of 8-24, or (2) an ester of an unsaturated alcohol having a carbon number of 8-24.

The ester (1) is synthesized by reacting the unsaturated aliphatic acid with a hydroxyl group containing compound, while the ester (2) is synthesized by reacting the unsaturated alcohol with a carboxyl group or acid anhydride group compound.

As the unsaturated aliphatic acid, there are exemplified only various long-chain monoaliphatic acids, which are entirely different from the aliphatic polyvalent carboxylic acid of the present invention. The polyoxyalkylene is exemplified as one of the hydroxyl group containing compounds, but is not described as the unsaturated alcohol.

Examples 8 to 12 of Igarashi describe esters of oleyl alcohol with maleic anhydride (Example 8), phthalic anhydride (Example 9), nonenyl succinic anhydride (Example 10), dodecyl succinic anhydride (Example 11) and styrene-maleic anhydride (1:) copolymer (Example 12), respectively.

In any case, Igarashi does not disclose or suggest the ester compound having carboxyl group and (poly)oxyalkylene group, as defined in the present invention.

Accordingly, Applicants respectfully submit that the present claimed invention is not anticipated or rendered *prima facie* obvious by Igarashi and withdrawal of this rejection is requested.

In Nohara (U.S. Patent No. 6,008,304), the compounds of the formulae (I), (II), (III) are acids not esters.

Also, the compound of formula (IV) is not an ester because the second substituent $-(\text{COXR}^6)_n$ in the formula (IV) never corresponds to the second substituent $-(\text{COO}(\text{R}^3\text{O})_q\text{R}^4)_s$ in the formula (II) defined in the present invention.

For example, the substituent $-(\text{COXR}^6)_n$ is $-(\text{COOR}^6)_n$ when X is O, and $-(\text{CONR}^8\text{R}^6)_n$ when X is NR^8 , and $-(\text{CO}(\text{R}^9\text{O})_q\text{R}^6)_n$ when X is $(\text{R}^9\text{O})_q$.

Therefore, Nohara also does not anticipate or render *prima facie* obvious the present claimed invention.


In view of the foregoing, withdrawal of the rejections is requested.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

RESPONSE UNDER 37 C.F.R. § 1.111
U.S. Appln. No. 09/923,533

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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WASHINGTON OFFICE

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CUSTOMER NUMBER

Date: September 18, 2003

NOTE: Federal Government closed
Thursday, September 18 and Friday,
September 19, 2003 due to
Hurricane Isabel. Deposited with
PTO on September 22, 2003.